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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,904	03/21/2000	Auvo K. Kettunen	10-1304	7934

7590 01/29/2002

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
1731	17

DATE MAILED: 01/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

GK: 17

Office Action Summary

Application No. 09/533,904	Applicant(s) KETTUNEN
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Examiner Dean T. Nguyen	Art Unit 1731
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Nov 29, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1835 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 and 47-53 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) Claim(s) 1-21 is/are allowed.

6) Claim(s) 47-53 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirem

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14, 15

20) Other: _____

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DETAILED ACTION

Information Disclosure Statement

1. The prior art statement filed 11/21/01 and 11/29/01 have been received and recorded.

Response to Amendment

2. The amendment filed 11/7/01 has been entered.

Statement Under 37 CFR 3.73(b)

3. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

- (a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or
- (b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

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An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action. A copy of "Statement under 37 CFR 3.73(b)" has not been received. The fax copies of 12/19/01 are not sufficient.

Claim Rejections Based Upon Recapture

4. Claims 47-53 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In application 08/736,112, which matured into U.S. Patent 5,779,856, applicant amended claim 16 to include the limitation in step (e) that the spent second (2nd) cooking liquor possessed an effective alkali concentration of greater than about "20 g/l". Similarly, claim 16 was also amended to recite the limitation that during at least the last fifteen minutes of step (e), the effective alkali concentration is between "20-40 g/l, so as to produce chemical pulp having enhanced intrinsic fiber strength compared to if the effective alkali concentration was below 15 g/l during the last fifteen minutes of step (e)". Both of these amendments to claim 16 were made to overcome the rejections involving US Patent 5,522,958 to Li. See the amendment of November 12, 1997, page 10, first and

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second paragraphs. Newly added claim 47, however, does not include these limitations which applicant presented in application 08/736,112 to overcome the prior art of record. Thus, applicant is attempting to recapture subject matter which was surrendered in application 08/736,112.

Claim Rejections - 35 USC § 112

5. The rejections of claims 47-53 under 35 U.S.C. 112, first paragraph, are withdrawn due to applicant's amendment.

Claim Rejections - 35 USC § 251

6. The rejections of claims 47-53 under 35 U.S.C. 251 are withdrawn.

Response to Arguments

7. Applicant's arguments with respect to the 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based is not persuasive since the subject matter of claim 16 of the original '856 patent is pertinent to the subject matter claimed by new claim 47 and the comparison is proper.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. When filing a FAX in Group 1300, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dean T. Nguyen whose telephone no. is (703) 308-2053. The examiner can normally be reached on Monday-Friday @ 7:00-4:30 PM (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stan Silverman, can be reached on (703) 308-3837. The fax phone number for this group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose tel. No. is (703) 308-0651.

dtn



DEAN T. NGUYEN
PRIMARY EXAMINER